

REMARKS

Reconsideration of the application is respectfully requested.

Claims 1-25, 27-35, 38-43, and 46-83 are pending. Claims 26, 36, 37, 44, and 45 are cancelled. Claims 81-83 were added. Claims 1, 5, 6, 27, 46, 58, 70, 71, and 72 have been amended.

Claims 1, 27, 46, 58, 70, 71, and 72 were amended to recite *wherein the carbon black is present at 80 to 200 phr*. Support for the amendment may be found, for example, in the inventive Examples 14, 15, 18, and 19, in Table 9 on page 50, inventive Examples 21 and 22, in Table 11 on page 52, and inventive Examples 24, 25, and 26, in Table 13 on page 54, along with originally filed claim 5.

Claims 5 and 6 were amended to refrain from reciting ranges of the carbon black.

New claims 81-83 are supported, for example, by the inventive Examples 14, 15, 18, and 19, in Table 9 on page 50, inventive Examples 21 and 22, in Table 11 on page 52, and inventive Examples 24, 25, and 26, in Table 13 on page 54, along with disclosure on page 25, paragraph [0068].

Thus, Applicants respectfully submit that the above amendments add no new matter.

CLAIM OBJECTIONS

Claims 5 and 6 were objected to for the reasons stated on pages 2-3 of the Action. Claims 5 and 6 have been amended to refrain from reciting ranges of the carbon black. Applicants respectfully request that the objection be withdrawn.

35 USC § 112

Claims 1, 27, 46, 58, and 70-72 were rejected under 35 USC § 112, first paragraph, for the reasons stated on page 3 of the Action. Claims 1, 27, 46, 58, 70, 71, and 72 were amended in manner consistent with the inventive Examples as described above including a closed-ended range as described in the Specification and mentioned in the Action. Applicants respectfully request that the rejection be withdrawn.

35 USC § 102

Claims 1-25, 27-35, 38-43, and 46-80 were rejected under 35 USC § 102(b) as being anticipated by WO 02/48257 to Dias *et al.* (herein "Dias") for the reasons stated on pages 4-5 of the Action. Applicants respectfully disagree. Applicants' independent claims 1, 27, 46, 58, 70, 71, and 72 recite, among other things, carbon black having a surface area of less than 30 m²/g and a dibutylphthalate oil absorption of less than 80 cm³/100 gm and is present at 80 to 200 phr. Applicants respectfully submit that, although Dias discloses some touching or overlapping ranges of a variety of fillers including a variety of carbon blacks (*See e.g.*, Dias at page 21, lines 10-20, *but compare with* page 26, lines 22-26, and, page 27, lines 1-19), the claimed range and type of carbon black is not disclosed with *sufficient specificity* and to be anticipated, since Applicants not only claim a specific sub-class of carbon blacks that belong to a larger group of fillers but also since Applicants claim certain narrow ranges (*see also*, new claims 81-83).

Applicants also point-out that Dias does not disclose specific examples of the Applicants' claimed ranges or types of carbon black. *See e.g.*, Table 3, page 37; Table 4, page 38; Table 5, page 39; Table 11, page 46; Table 12, page 47; and Table 14, page 50. The absence of such examples is noteworthy because although the reference must be taken as a whole as the Examiner points-out on page 5 of the Action, the MPEP provides that

[w]hen the prior art discloses a range which touches, overlaps or is within the claimed range, *but no specific examples falling within the claimed range are disclosed*, a case by case determination must be made as to anticipation. In order to anticipate the claims, the claimed subject matter must be disclosed in the reference with "sufficient specificity to constitute an anticipation under the statute." What constitutes a "sufficient specificity" is fact dependent. If the claims are directed to a narrow range, the reference teaches a broad range, and there is evidence of unexpected results within the claimed narrow range, depending on the other facts of the case, it may be reasonable to conclude that the narrow range is not disclosed with "sufficient specificity" to constitute an anticipation of the claims.

(M.P.E.P. § 2131.03 II.) (emphasis added).

Therefore, in light of these circumstances, given all the types of carbon blacks disclosed by Dias along with its broad disclosure of fillers and the ranges by which they may be employed,

Applicants respectfully submit that the pending claims are not anticipated by Dias and request that the rejection be withdrawn.

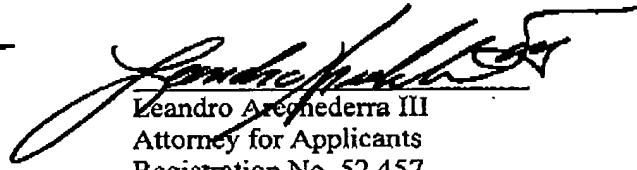
35 USC § 103

Claims 26, 36, 37, 44, and 45 were rejected under 35 USC § 103(a) as being unpatentable over Dias in view of EP 0 376 558 to Kay *et al.* (herein "Kay") for the reasons stated on page 4 of the Action. Applicants have cancelled the subject claims with leave to filing a continuing application directed to this subject matter and respectfully request that the rejection be withdrawn.

Applicants respectfully request that all rejections be withdrawn and respectfully solicit a prompt notice of allowance. Applicants invite the Examiner to telephone the undersigned attorney if there are any issues outstanding which have not been presented to the Examiner's satisfaction.

Respectfully submitted,

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Date


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